REMARKS/ARGUMENTS

Reconsideration and allowance of this application are respectfully requested. Currently, claims 57-108 are pending in this application.

Rejection Under 35 U.S.C. §102:

Claims 57-106 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Sims, III (U.S. '011, hereinafter "Sims"). Applicant respectfully traverses this rejection.

For a reference to anticipate a claim, each element must be found, either expressly or under principles of inherency, in the reference. Each element of the claimed invention is not found in Sims. For example, Sims fails to disclose "receiving a transfer authorization request having an indicator of the first device, an indicator of the second device, and an indicator of the protected electronic content; [and] updating a first device history table to indicate that the first device is not authorized to render the protected electronic content and updating a second device history table to indicate that second device is authorized to render the protected electronic content based on the received transfer authorization request (emphasis added)," as required by independent claim 57. Independent claim 83 and its dependents require similar features. Sims also fails to disclose "communicating a transfer authorization request to transfer authorization to render the protected electronic content from the first device to the second device, the transfer authorization request having an indicator of the first device, an indicator of the second device, and an indicator of the protected electronic content

(emphasis added)," as required by independent claim 97 and its dependents. Independent claim 99 requires similar limitations.

The above noted claim limitations are supported by, for example, pages 99-128 of the originally-filed specification. In particular, attention is directed to the section of the originally-filed specification labeled "Transferring music from lost or damaged devices" beginning on page 106 and the section of the labeled "Transferring music" beginning on page 119.

The U.S. filing date of Sims (U.S. '011) is October 7, 1999 (after the July 29, 1999 filing date of the present application). While Sims (U.S. '011) is a continuation-in-part of parent application no. 09/129,370 (now U.S. Patent No. 6,438,235) filed on August 5, 1998, those portions of Sims (U.S. '011) which are not supported by the parent application are not entitled to its earlier filing date.

Applicant submits that at least some of the subject matter relied upon to make the rejection of claims 57-106 in the present application is not supported by the parent application and thus does not qualify as prior art against the present application since that subject matter is only entitled to the October 7, 1999 filing date of the continuation-in-part. For example, but without limitation, col. 17, lines 54-61 (specifically identified by the Office Action) states, *inter alia*, "The content and/or the content use information may be transmitted with the content key from the host device, such as through the same links used for communication of the content key." This teaching, specifically identified in the Office Action and relied

upon in the rejection of the claims, is not supported by the parent application and thus does not qualify as prior art.

Even if all of the teachings of Sims (U.S. '011) qualified as "prior art," Sims would still not disclose all of the claim limitations. Col. 10, lines 43-64 (also specifically identified by the Office Action) discloses the following:

> "The preferred embodiment of the present invention utilizes both public and private key cryptography. For example, public key cryptography is utilized to distribute keys allowing for subsequent encrypted communications, such as the transfer of an encrypted content key through an unsecure communication channel. Accordingly, a public key may be provided from one compliant device, such as a playback device, to another compliant device, such as a storage device, through an unsecure communication channel to enable the other compliant device to encrypt a secret content key, and possibly other data associated with the particular content, and transfer this encrypted key back through the channel to the other device. Thereafter, content protected, and presumably also communicated between the devices through the unsecure communication channel, using encryption with this secret key may be decrypted for use by the receiving device. As it is presumed that the content, such as a musical work or a video production, will include substantially more data than ancillary communications, such as the content key, the utilization of both public and private key cryptography is preferred to provide a desired level of security and to optimize the utilization of resources."

While this passage of Sims discloses providing a public key from one compliant device to another compliant device, this portion of Sims fails to disclose receiving a transfer authorization request, let alone the transfer authorization request having an indicator of a first device, an indicator of a second device, and an indicator of the protected electronic content. Col. 17, line 62 to col. 18, line 17

of Sims (also identified in the Office Action) also fails to teach or suggest this limitation.

Independent claims 57 and 83 further require updating a first device history table to indicate that the first device is not authorized to render the protected electronic content. This feature is clearly not taught or suggested by Sims. That is, Sims fails to disclose de-authorizing rendering of protected electronic content.

Independent claim 71, requires, *inter alia*, "receiving an authorization to render request having an indicator of the first device, an indicator of the second device, and an indicator of the protected electronic content; updating a second device history table to indicate that the second device is authorized to render the protected electronic content based on the received authorization to render request, a first device history table indicating that the first device remains authorized to render the protected electronic content" Independent claims 90, 98 and 100 requires similar (but not identical) limitations. Applicant submits that Sims's teaching of a acceptable device list fails to teach or suggest a first and second device history table. Moreover, Sims fails to further teach or suggest an authorization to render request having an indicator of both a first device and a second device. By providing such an authorization request, the present invention required by claims 71, 90, 98 and 100 provides the benefit of enabling, for example, the second device to render the content at a special charge rate in view of the continued authorization of the first device.

New Claims:

New claims 107 and 108 have been added to provide additional protection for the invention. Claims 107 and 108 depend from claims 97 and 99, respectively, and are thus believed to be allowable for at least the reasons discussed above with respect to these base independent claims.

Conclusion:

Applicant believes that this entire application is in condition for allowance and respectfully requests a notice to this effect. If the Examiner has any questions or believes that an interview would further prosecution of this application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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